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09/711,279	11/10/2000	Peter I. Clarke	ERC-DATA	6853

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EXAMINER
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GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/711,279

Applicant(s)  
Peter I. CLARKE et al.

Examiner  
Stephen M. Gravini

Art Unit  
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6-21-01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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## **DETAILED ACTION**

### ***Requirements for Information***

1. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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2. The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicants' professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use. Since the application is filed as a small entity status, along with the fact that the assignee has federally registered trademarks closely related to the claimed invention (i.e. AGROS, Seletech, or Teleclock), it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination may be performed by the Office.

### ***Claim Objections***

3. Claim 7 is objected to because it is not a complete sentence as required by Office procedures. That claim does not end with a period. Appropriate correction is required.

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***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of requesting, receiving, scoring, and sending does not require structural interaction or mechanical intervention such that the invention falls within the technological arts permitting statutory patent protection. Examiner considers the claimed computer program code merely a patentable equivalent to a person communicating and receiving information in the same way as a scheduler, programmer, or other equivalent terms. The recited code does not limit the claimed invention to a machine or mechanical process and can be broadly interpreted to be purely non statutory subject matter under this statute. Claims reciting those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject

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matter. Furthermore each of the claimed steps can be completely performed by a human which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the independently claimed apparatus or method including the step of receiving input information and scoring a portion of the information received is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed invention specifically reciting those steps is considered non-enabling because the specification

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does not provide a concrete example or illustrating of those claimed steps. The specification discusses this claimed concept but does not enable one skilled in the art how the step of receiving input information and scoring a portion of the information received is enabled, based on the specification, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed apparatus or method including the step of receiving input information and scoring a portion of the information received fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps specifically reciting either of those features are considered indefinite because the specification does not provide an antecedent basis of that step. The specification discusses this claimed concept but the claims do not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification in light of the claims, the claims are indefinite. Some of the claims



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are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the world wide web" (claims 2 and 9), "the one" (claim 6), "the qualifications" and "the steps" (claim 7), and "the employer" - singular first occurrence and multiple occurrences (also claim 7). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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11. Claims 1-12 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art. Claims 1-12 are also rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fields et al. (US 5,111,391), Stipanovich et al. (US 5,117,353), Clark et al. (US 5,164,897), Sobotka et al. (US 5,197,004), Tengel et al. (US 5,940,812), or McGovern et al. (US 5,978,768), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barney et al. (US 6,070,143), Ratsaby et al. (WO 00/70481), Emodi et al. (EP 1 160 714), Agrawal et al. (US 6,233,575), Tang et al. (WO 01/37597), Roitblatt (WO 01/42984), or Milsted et al. (US 6,345,256).

12. Claims 1-12 are further rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An Office search of federally registered trademarks by applicants' small entity claimed parent company, ERC-Data plus, reveals that the claimed invention has been in public use since at least 1994, based on several federally registered trademarks admitting the claimed

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invention was in public use, which is more than one year from the filing date of the present application. Those trademarks include AGROS, Seletech, or Teleclock.

13. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: other business ventures regarding the claimed invention in public use as known the applicants and the assignee.

Applicants are reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of an apparatus or method of employment candidate qualification as provided by examiner federal employment application. The claimed candidate, alphanumeric score, form fields, referral data, and employment seeking are considered non-functional descriptive material which will be discussed infra. The claimed server, first computer program, world wide web, home web page, hyperlinks, and computer are considered automated features of an old and well known manual operation which will also be discussed infra. The claimed apparatus or method of gathering information about candidates seeking employment are considered to be patentably equivalent to the examiner experience of using the USPTO automated job application system in applying for the current position as a patent examiner based on the broadest reading of the claims under the *Graham* decision. Since at least 1994, examiner has experience with the claimed invention as a federal employment applicant. The claimed apparatus or method comprising:

a server having a memory and a database defined in the memory;

a candidate in communication with said server, said server communicating a plurality of form fields to said candidate, said form fields requesting input data from said candidate, said input data being added to the database; and

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a first computer program, whereby said program processes the input data and associates an alphanumeric score with the candidate, said score being added to the database; or

requesting information from an employment seeking candidate using a computer associated with said employment seeking candidate, said computer associated with said employment seeking candidate communicating with a central computer facility over a communication system;

receiving information from said employment seeking candidate;

scoring a portion of the information received based on criteria established by the employer;

sending said information received from the employment seeking candidate and score to a database; and

sending notification of said information received to the employer are part of examiner's personal experience. Examiner's personal experience also includes the claimed world wide web, home web page, hyperlinks, three-dimensional graphical buttons, blank computer screen form, and first and second web page forms. The claimed server having a memory and a database defined in the memory is considered equivalent to examiner calling the automated USPTO information receiving server for storing examiner information related to employment with the USPTO. The claimed candidate in communication with said server, said server communicating a plurality of form fields to said candidate, said form fields requesting input data from said candidate, said input data being added to the database or requesting information from an

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employment seeking candidate using a computer associated with said employment seeking candidate, said computer associated with said employment seeking candidate communicating with a central computer facility over a communication system including receiving information from said employment seeking candidate is considered equivalent the examiner providing information in response to automated questions from the USPTO employment application telephone server database. The claimed first computer program, whereby said program processes the input data and associates an alphanumeric score with the candidate, said score being added to the database or scoring a portion of the information received based on criteria established by the employer and sending said information received from the employment seeking candidate and score to a database and sending notification of said information received to the employer is considered equivalent to the USPTO using examiner provided information to score the employment application for the best area of employment with the USPTO. The claimed world wide web, home web page, hyperlinks, three-dimensional graphical buttons, blank computer screen form, and first and second web page forms are old and well known to those skilled in similar areas of examiner experience and are considered part of federal employment application included in examiner's experience. The claimed invention has been performed by the examiner long before the filing of the present invention except for the specifically recited candidate, alphanumeric score, form fields, referral data, and employment seeking. Those recitations are considered non-functional descriptive language and are not given patentable weight. It would have been obvious to those skilled in the art of the claimed method to use those recitations to

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seek patent protection. The non-functional descriptive language including candidate, alphanumeric score, form fields, referral data, and employment seeking are considered merely information or data item necessary to provide an accounting for establishing and maintaining an information basis in the field of endeavor claimed by the applicants. This non-functional descriptive language difference is only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed candidate, alphanumeric score, form fields, referral data, and employment seeking would be performed the same regardless of the data or information. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim a apparatus or method particularly candidate, alphanumeric score, form fields, referral data, and employment seeking, because such data or information does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Also, the claimed invention contains automated features, such as server, first computer program, world wide web, home web page, hyperlinks, and computer which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. Server, first computer program, world wide web, home web page, hyperlinks, and computer, as discussed in the specification, are interpreted to encompass automated electronic communications associated with electronic mail, Internet, and/or computer

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to server communications. The claimed invention, recited by the applicant, has been provided to examiner by personal experience long before the filing of applicant's invention but with an automated obvious variation. Examiner notes that it is old and well known to those skilled in the art of the claimed apparatus or method, that it would have been obvious to claim the invention as recited by the applicants, in order to overcome the explicit teachings of examiner's personal experience discussed supra. It would have been obvious to one skilled in the art to provide the automated claimed apparatus or method since those features, particularly server, first computer program, world wide web, home web page, hyperlinks, and computer, are merely automated features of a concept that is old and well known. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. The motivation to combine applicants' claimed invention with the services offered by the examiner federal employment application experience is to allow greater consumer targeting capabilities through electronic mediums, while transferring information, which clearly shows the obviousness of the claimed invention.




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*Conclusion*

17. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325

  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg

July 8, 2003